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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,351	02/24/2004	Elizabeth Kornecki	19658Z	8733
7590	06/18/2008		EXAMINER	
Peter I. Bernstein			WANG, CHANG YU	
Scully, Scott, Murphy & Presser, P.C.				
Suite 300			ART UNIT	PAPER NUMBER
400 Garden City Plaza			1649	
Garden City, NY 11530				
			MAIL DATE	DELIVERY MODE
			06/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/785,351	<b>Applicant(s)</b> KORNECKI ET AL.
	<b>Examiner</b> Chang-Yu Wang	<b>Art Unit</b> 1649

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 March 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 18 and 21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/DS/02)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

**RESPONSE TO AMENDMENT**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/27/08 has been entered.

***Status of Application/Amendments/claims***

2. Applicant's amendment filed 3/27/08 is acknowledged. Claims 1-17 and 19-20 are cancelled. Claim 18 is amended. Claim 21 is newly added. Claim 18 and newly added claim 21 are pending in this application and under examination in this office action.
3. Any objection or rejection of record, which is not expressly repeated in this action has been overcome by Applicant's response.
4. Applicant's arguments filed on 3/27/08 have been fully considered but they are not deemed to be persuasive for the reasons set forth below.

***Claim Rejections/Objections Withdrawn***

5. The rejection of claim 18 under 35 U.S.C. 112, first paragraph, because the specification does not enable the invention commensurate in scope with the claims is

withdrawn in response to Applicant's amendment to the claim by reciting specific hybridization conditions.

The rejection of claim 18 under 35 U.S.C. 112, first paragraph, for failing to comply with the written description requirement is withdrawn in response to Applicant's amendment to the claim.

The rejection of claim 18 on the grounds of nonstatutory double patenting over claim 1 of U. S. Patent No. 6699688 is withdrawn in response to Applicant's submission of terminal disclaimer.

The rejection of claim 18 under 35 U.S.C. 112, second paragraph, for being indefinite is withdrawn in response to Applicant's amendment to the claim by reciting specific conditions for a high stringency condition.

#### ***Claim Rejections/Objections Maintained***

In view of the amendment filed on 3/27/08, the following rejections are maintained.

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by GenBank accession number AA101561, October 1996. The rejection is maintained for the reasons made of record in the office action mailed 12/27/07, and as follows.

At p. 5 of the response, Applicant argues that the rejection is overcome because amended claim 18 no longer recites SEQ ID NO:2 or its fragments. Applicant's argument has been fully considered but it is not persuasive.

In contrast, the DNA molecule with the GenBank accession no. AA101561 meets the limitation of the DNA oligomer recited in amended claims 18 and 21 because GenBank accession no. AA101561 discloses a molecule (oligomer) that is 99.2% identical to SEQ ID NO:2 of the instant application over a region of 377 bases and SEQ ID NO:2 is 74.5% identical to the whole molecule of instant SEQ ID NO:1 as recited in instant claims and with 99.1% local similarity. Thus, the DNA fragment (oligomers) of AA101561 can hybridize to a DNA molecule having a nucleotide sequence of nucleotides 16-912 or 97-912 of SEQ ID NO:1 with high stringency conditions as recited in instant claim 18.

In addition, the recitation "a DNA oligomer having a nucleotide sequence of nucleotides 16-912 or 97-912 of SEQ ID NO:1" as recited in instant claim 21 is interpreted as a DNA molecule comprising a nucleotide sequence of nucleotides 16-912 or 97-917 of SEQ ID NO:1, which is open language, and thus could encompass a DNA molecule (oligomer) comprising any fragments with different lengths of nucleotides 16-912 or 97-912 of SEQ ID NO:1 including probes with a short sequence of nucleotides 16-912 or 97-912 of SEQ ID NO:1. Furthermore, "a DNA oligomer having a nucleotide sequence of nucleotides 16-912 or 97-912 of SEQ ID NO:1" as in claim 21 also could encompass different length fragments of nucleotides 16-912 or 97-912 of SEQ ID NO:1 versus the whole molecule of nucleotides 16-912 or 97-912 of SEQ ID NO:1. Thus, any

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DNA oligomer can hybridize to probes derived from SEQ ID NO:1, which would meet the limitation recited in amended claim 18 and the limitation of claim 21. Accordingly, the rejection of claims 18 and 21 under 35 U.S.C. 102(b) for being anticipated by GenBank accession number AA101561 (October 1996) is maintained.

***Conclusion***

**7. NO CLAIM IS ALLOWED.**

8. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Papers relating to this application may be submitted to Technology Center 1600, Group 1649 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chang-Yu Wang whose telephone number is (571) 272-4521. The examiner can normally be reached on Monday-Thursday from 8:30 AM to 6:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Stucker, can be reached at (571) 272-0911.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/CYW/

Chang-Yu Wang, Ph.D.  
May 30, 2008

/Jeffrey Stucker/  
Supervisory Patent Examiner, Art Unit 1649